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| 10/561,704 | 12/22/2005 | Jorn Karl | 12810-00184-US | 8192 |
| 23416 7590 06/18/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899 | | | | |
| EXAMINER | | | | |
| ROGERS, JAMES WILLIAM | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,704

Applicant(s)

KARL ET AL.

Examiner

JAMES W. ROGERS

Art Unit

1618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-15, 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, 14-15, 21, 24-27 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 22-23 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 12/22/2005 and 01/11/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5 and 22-28, drawn to a preparation comprising at least one hydroformate.

Group II, claim(s) 6 and 8, drawn to a process for preparing coated preparations by charging a hydroformate optionally with other additives and coating the resultant mixture with a coating material.

Group III, claim(s) 7, drawn to a process for preparing coated preparations by charging a coating material optionally with other additives and adding a hydroformate optionally with other additives.

Group IV, claim(s) 9, drawn to a process for preparing coated preparations by dispersing a hydroforate and optionally other additives into a melt of suitable coating materials and finely dividing and solidifying the resultant dispersions.

Group V, claim(s) 10 and 29 drawn to a process for preparing coated preparations by dispersing a hydroformate optionally with other additives in a coating material, emulsifying in an aqueous solution of a protective colloid and subjecting it to shaping by spraying and drying.

Group VI, claim(s) 11, drawn to process for preparing coated preparations which comprises coating at least one hydroformate by desublimating the coating material.

Group VII, claim(s) 14, drawn to a process of preparing a feed and or feed additive by adding a hydroformate to a premix and mixing the remaining constituents of the feed or feed additive.

The inventions listed as Groups 1-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons: particularly the preparation of hydroformate does not have to be prepared using the methods described within groups II-VII; the preparation only requires a hydroformate and does not have to include a so called coating material as required in groups II-VII. For instance Slaney et al. (WO03/040078) described below only states that a starch material (meets claimed coating material) can be compressed with the hydroformate, this composition is within the scope of applicants claimed groups I, however it teach the technical features, specifically the processes of manufacture of groups II-VII. Furthermore the process claims II-VII all claim different technical aspects of manufacture and therefore do not share the same technical feature.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The various uses of the preparations claimed within claims 15,21,23-27, selected from animal feed, performance enhancer and or/growth enhancer, an acidifier, a preservative, a silage additive and a fertilizer.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 15,21 and 23-27.

During a telephone conversation with Ashley Pezzner, Reg. No. 35,646 on 6/9/2009 a provisional election was made with traverse to prosecute the invention of group I and the species of a performance enhancer and or growth promoter, claims 1-5,22-23 and 28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-11,14-15,21,24-27 and 29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Spherically at part f) second line it is not clear why "poly(vinyl phthalate)" is present when f) is directed to poly(vinyl alcohol). It appears as though poly(vinyl phthalate) is a separate species and was unintentionally included in the species poly(vinyl alcohol) and the examiner will interpret it as such. Correction is required.

Claims 4 and 28 recite the limitation "coating material" in line 2 of each. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Slaney et al. (WO 03/040078, US 6,906,222 B2 used as English equivalent).

Slaney teaches methods of preparing formic acid formates including preferably trisodium tetraformate, the acid formates were said to be useful in preserving or acidifying materials of plant or animal origin and for animal nutrition as growth promoters. See abstract, col 1 lin 6-9, lin 66-col 2 lin 35, col 6 lin 29-col 7 lin 17. Regarding the limitation within the preamble that the preparation is a coating, the examiner considers the limitations met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I, ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); Kropa v. Robie, 187 F.2d at 152, 88 USPQ2d at 480-81. Slaney further teaches that it is advantageous to compress the acid formates with a desiccant including starches. See col 6 lin 59-64.

Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjornevik (US 6,137,005).

Hjornevik teaches formate based products containing salts of formic acid including a mixture of diformate/trisodium tetraformate. See abstract and examples. The formate based product could be used as an animal feed. As stated above the limitation within the preamble that the preparation is a coating, the examiner considers that limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. A desiccant such as starch could be added to the formats to further dehydrate the formats. See col 2 lin 18-20.

Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjornevik (EP 1,273,238 A2, cited in applicants IDS).

Hjornevik teaches the use of animal feed additives that are useful in promoting growth including diformate salts such as trisodium tetraformate. See [0003],[0008]-[0009],[0014]-[0015],table 1a. As stated above the limitation within the preamble that the preparation is a coating, the examiner considers the limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. A desiccant such as starch could be added to the formats to further dehydrate the formats. See [0014].

Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnsen et al. (6,132,796).

Johnsen teaches a method of producing feed for salmonides, the feed incorporated trisodium tetraformate. See abstract and examples including table 1 and 2. As stated above the limitation within the preamble that the preparation is a coating, the

examiner considers the limitation met since the limitation of the claim itself is contained in the body of the claim which only requires the composition to contain a hydroformate of formula I. The feed included numerous ingredients such as fish meal, grounded wheat, digestible starch, pigments, minerals and vitamins.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 22-23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foxcroft et al. (EP 0,009,366, cited in IDS) in view of Slaney et al. (WO03/040078, US 6,906,222 B2 used as English equivalent).

Foxcroft discloses milk containing animal feed containing sprayed on stabilizers (preservatives) such as ammonium tetraformate. See pag 2 lin 1-20, lin 48-pag 3 lin 5, lin 39-43 and examples. Foxcraft discloses that the particle size of the carrier is preferably in the range of 80 to 200 microns. See pag 3 lin 22-24. The carriers can contain inert materials and nutrients such as starches. See pag 3 lin 25-30. Foxcroft while disclosing tetraformate preservatives does not disclose specific tetraformates within applicants claimed formula I.

Slaney is disclosed above and is used primarily for the disclosure within that formates within applicants claimed formula were well known at the time of the invention to be useful as preventives for animal feed products.

It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the formates disclosed in Foxcroft and add the specific formates such as trisodium formate disclosed within Slaney. It is generally considered to be prime facie obvious to combine/substitute compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining or substituting them flows from their having been used individually in the prior art, and from them being recognized

in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination or substitution of conventional components of animal feed formate preservatives. It therefore follows that the instant claims define prime facie obvious subject matter.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618